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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,363	09/15/2000	Yoon Kean Wong	PALM-3303.US.P	2503
7590 04/20/2004 Wagner Murabito & Hao L L P Two North Market Street Third Floor San Jose, CA 95113			EXAMINER FRENEL, VANEL	
			ART UNIT 3626	PAPER NUMBER

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/663,363

Applicant(s)

WONG, YOON KEAN

Examiner

Vanel Frenel

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/23/04 has been entered.

Notice to Applicant

2. This communication is in response to the RCE filed on 01/23/04. Claims 1-24 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-2, 4-8 and 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory

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subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "computer-implemented". Looking at the claims 1-2, 4-8 and 21-24 as a whole, nothing the body of these claims recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces determining a clock time of day (i.e., repeatable) in setting a default data category based upon the clock time of day and the time of day profile (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-2, 4-8 and 21-24 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goyal et al. (5,873,108) in view of Koyabu et al. (6,026,333).

(A) As per claim 1, Goyal teaches a computer implemented of automating categorization of data comprising:

determining a clock time of day (Goyal; abstract, col. 8, lines 35-38, and col. 11, lines 21-25);

setting a default data category based upon the time clock of day and the time of day profile (Goyal; col. 11, lines 21-25; the Examiner interprets the "current day" as the "default category.")

Goyal fails to expressly teach referencing a time of day profile that correlates clock time of day information with data categories. However, this feature is old and well known in the art, as evidenced by Koyabu's teachings with regards to referencing a time of day profile that correlates time of day information with data categories (Koyabu; abstract; the Examiner interprets the "category definition dictionary" as the "time of day profile.") It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Goyal with Koyabu's teaching with regards to this limitation, with the motivation of

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determining the categorization rules associated with a time of day and related data categories (Koyabu; col. 1, lines 60-col. 2, line 5).

(B) As per claim 2, Goyal fails to expressly teach wherein the time of day profile correlates a clock time with at least one of a personal data category and a business category. However, this feature is old and well known in the art, as evidenced by Koyabu's teachings with regards to wherein the time of day profile correlates a time with at least one of a personal data category and a business category (Koyabu; col. 7, lines 35-53). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Goyal with Koyabu's teaching with regards to this limitation, with the motivation of associating a time of day with at least one of a related personal data category and a business category (Koyabu; col. 1, lines 60-col. 2, line 5).

(C) As per claim 3, Goyal teaches wherein the computer implemented method is carried out within a personal information manager program operating on a programmed processor residing within a palmtop computer (Goyal; col. 3, lines 5060).

(D) As per claim 4, Goyal teaches displaying only data categorized in the default data category and hiding information categorized in any other category (Goyal; figure 3 and col. 11, lines 21-25).

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(E) As per claim 5, Goyal teaches entering data categorized in the default category (Goyal; col. 11, lines 28-31).

(F) Claims 6 and 7 differ from 5 and 4, respectively, by reciting "providing an option to change the default data category to a selected data category." The combined system of Goyal and Koyabu collectively fail to expressly teach this limitation. However, since the combined system of Goyal and Koyabu collectively do teach providing an option of manually changing data categories (Goyal; col. 8, lines 31-46) the default data category is the initial data category where data can be entered, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Goyal and Koyabu to provide an option to change the default data category to a selected data category, with the motivation of enabling the user to specify which data category should the data be entered in.

(G) As per claim 8, Goyal teaches wherein the data comprises one of address book data, to-do list data, notes data, email data and calendar data (Goyal; col. 2, lines 40-56).

(H) Apparatus claims 9-15 repeat the subject matter of method claims 1, 2, 4, 5, 6, 7, and 8, respectively as a set of apparatus elements rather than a series of steps. As the underlying processes of claims 1, 2, and 4-8 have been shown to be fully disclosed by the teachings of Goyal and Koyabu in the above in the rejection of claims 1, 2, and 4-8,

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it is readily apparent that the system disclosed by Goyal and Koyabu include' the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1, 2, and 4-8, and incorporated herein.

(I) Claims 16-20 differs from method claims 1, 2 and 8, 3, 6, and 7 by reciting a "an electronic storage medium containing instructions, which when carried out on a programmed processor..." in the preamble. As per this limitation, Goyal system is implemented on a computer (Goyal; col. 3, lines 1150-61). As such, Goyal implicitly includes computer elements such as a programmed computer readable medium. The remainder of claims 16-20 repeat the limitations of claim 1-3 and 6-8, and are therefore rejected for the same reasons given above for claim 1-3 and 6-8.

(J) As per claim 21, Goyal discloses a computer- implemented method of automating categorization of data, comprising: determining a current time of day (Col.8, lines 35-38; Col.11, lines 21-25); setting a default data category based upon said current time of day and said time of day profile (Goyal, Col.11, lines 21-25 The Examiner interprets the "current day" as the "default category"); and performing actions only within said default data category (Col.11, lines 21-54).

Goyal fails to expressly teach referencing a time of day profile that correlates clock time of day information with data categories. However, this feature is old and well known in the art, as evidenced by Koyabu's teachings with regards to referencing a time

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of day profile that correlates clock time of day information with data categories (Koyabu; abstract; the Examiner interprets the "category definition dictionary" as the "time of day profile.") It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Goyal with Koyabu's teaching with regards to this limitation, with the motivation of determining the categorization rules associated with a time of day and related data categories (Koyabu; col. 1, lines 60-col. 2, line 5).

(K) As per claim 22, Goyal discloses the method wherein actions is taken from a list consisting of: creating a data entry (Col.3, lines 50-67 to Col.4, line 32); editing a previously created data entry (Col.7, lines 31-67); retrieving said previously created data entry (Col.7, lines 31-67); displaying data in said previously created data entry (Col.4, lines 47-64); and querying said default data category (Col.9, lines 43-67 to Col.10, line 24).

(L) As per claim 23, Goyal discloses the method wherein said current time of day comprises: current time information (Col.4, lines 41-64); current day of the week information (Col.4, lines 41-67 to Col.5, lines 49-67); current month of the of the year information (Col.4, lines 41-67 to Col.5, lines 49-67); and current year information (Col.4, lines 41-67 to Col.5, lines 49-67).

(M) As per claim 24, Goyal discloses the method further comprising: changing said default data category to another data category for performing actions only within said another data category (Col.5, lines 49-67 to Col.6, line26).

Response to Arguments

6. Applicant's arguments filed 01/23/04 regarding claims 1-24 have been considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 01/23/04.

(A) At pages 9-13 of the 01/23/04 response, Applicant's argues that the features in the 01/23/04 amendment are not taught by or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 01/23/04 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Goyal and/or Koyabu based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 4), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches a schedule and to-do list for a pen-based computer system (5,570,1090); a method for controlling a computerized organizer (5,457,476); a voice activated personal organizer (5,602,963); a biorhythms analog computer-calendar (4,551,620); a system and method for creating pattern-recognizing computer structures from example text (5,864,789); a method and system for automatically integrating scheduled work items onto an electronic g0jendar (5,899,979); a method and apparatus for randomly generating information for subsequent correlating (5,917,493); a method and system for resolving temporal descriptors of data records in a computer system (6,345,268); and an intelligent agent for executing delegated tasks (5,983,200).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952.

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The examiner can normally be reached on Monday through Thursday, 6:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-

1113.

V.F

V.F

April 19, 2004

Alexander P. Caligaris
Alexander P. Caligaris
Primary Examiner
Art 3626